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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/747,623

**Applicant(s)**

ENETE ET AL.

**Examiner**

Stephen Alvesteffer

**Art Unit**

2175

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 3, 5-27, 29 and 31-56 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 5-27, 29 and 31-56 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/06)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

This Office Action is responsive to the amendment filed March 14, 2008. Claims 1, 3, 5-8, 22-27, 29, 31-34, and 48-56 are amended. Claims 2, 4, 28, and 30 are cancelled. Claims 1, 26, 27, and 52 are independent. Claims 1, 3, 5-27, 29, and 31-56 remain pending.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 27, 29, and 31-52** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims recite a computer program stored on a tangible computer readable medium. The specification states that the computer readable medium comprises a propagated signal (see specification page 4, lines 2-4), which is non-statutory according to MPEP 2106. A propagated signal does not fall under any of the statutory categories of invention provided by 35 U.S.C. 101 because it is not a new and useful process, machine, manufacture, or composition of matter. Furthermore, the claims recite software *per se* because no execution of the instructions is recited. The claims merely recite storage of a listing of instructions.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 5-11, 19-27, 29, 31-37, and 45-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hashemi, United States Patent Application Publication 2003/0212804, and Liwerant et al. (hereinafter Liwerant), United States Patent Application Publication 2002/0056123.

**Regarding claim 1**, Hashemi teaches a computer implemented method for sending a video clip in an instant messaging communications session, the method comprising: establishing an instant messaging communications session between an instant message sender using a client computer and an instant message recipient using another client computer (see Hashemi paragraph [0047]; *"One embodiment permits the users within a peer group to simultaneously chat while a media clip may advantageously be streamed from one user in the peer group to other users in the peer group"*); during the instant messaging communications session that has been established between the instant message sender and the instant message recipient: providing the instant message sender with access to the collection of video clips stored on the host system (see Hashemi paragraph [0047]; *"The exemplary media clip browse window 204 displays a list of peers that may advantageously be signed in or logged onto the central server 102 and displays the media clips from the peers that may*

*advantageously be available for streaming"); receiving, at the host system, a request from the instant message sender's client computer for a particular video clip from among the collection of video clips stored on the host system to be delivered to the instant message recipient's client computer within the instant messaging communications session that has been established between the instant message sender and the instant message recipient (see Hashemi paragraph [0060]; "In one embodiment, the streaming of a media clip may advantageously be sent to a peer group or subset of a peer group by a member of the peer group that initiates streaming to the peer group of the subset"); in response to receiving the request from the instant message sender for the particular video clip to be delivered to the instant message recipient's client computer, sending, within the instant messaging communications session that has been established between the instant message sender and the instant message recipient, a video clip identifier corresponding to the particular video clip to the instant message recipient's client computer (see Hashemi paragraph [0081]; "The File Reference field 616 can contain information such as a filename and path for the corresponding media clip on the user computer identified in the Peer Computer Reference field 612", a media clip identifier inherently must be sent to the instant message recipient); after sending the video clip identifier corresponding to the particular video clip to the instant message recipient's client computer within the instant messaging communications session that has been established between the instant message sender and the instant message recipient, receiving, from the instant message recipient's client computer, a request for the particular video clip, the request for the*

particular video clip including the video clip identifier (see Hashemi paragraph [0025]; "*A media clip selection module 136 permits a user to select which media clips from a list of media clips may be received in a stream from another user computer*"); and in response to receiving the request for the particular video clip including the video clip identifier, leveraging the video clip identifier to access the particular video clip from the collection of video clips stored at the host system and communicating the particular video clip from the host system to the instant message recipient's client computer within the instant messaging communications session that has been established between the instant message sender and the instant message recipient for rendering (see Hashemi paragraph [0039]; "*Streaming of a media clip advantageously permits the computer receiving the stream to play or display the media clip while the media clip transfers and before an entire file has been transferred*").

Hashemi does not teach storing, on a host system that is separate from both the client computer of the instant message sender and the client computer of the instant message recipient, a collection of video clips that are available to be sent to instant message recipients in instant messaging communications sessions. Rather, Hashemi describes that media clips are stored on the local computers of the members of the peer group and that media clips are streamed directly from the local computers of members of the peer group to the local computers of other members of the peer group. Liwerant teaches a method of sharing a video segment over a computer network that comprises storing, on a host system that is separate from both the client computer of the instant message sender and the client computer of the instant message recipient, a collection

Art Unit: 2175

of video clips that are available to be sent to instant message recipients in instant messaging communications sessions (see Liwerant paragraph [0082]; *"the video segment recorded on the hard drive of the computer 16 is transmitted with one or more identifiers to the host computer 60 that includes the VideoShare servers 62, 62' and the storage array 64. The video segment is stored under the control of the host computer 60, which can generate an identification tag that the host computer 60 can use to locate the stored video segment for retrieval and for viewing. In different embodiments, the identification tag can be provided to a user in the form of a URL, or can be embedded into a Web page on a remote site, or can be linked to a message... the user who stored the video can send a message to an intended viewer, so that the viewer can access and view the video segment... the viewer activates a link by clicking a button, and the server computer 62, 62' responds by sending a streaming video segment that the viewer observe"*). It would have been obvious to one of ordinary skill in the art at the time the invention was made to store video clips on a host server prior to sharing them as taught by Liwerant in the invention of Hashemi as a design choice. Liwerant further suggests that such a combination would be desirable in paragraph [0164], *"The "Share Through ICQ Messaging" button 830 can bring up ICQ's Instant Messenger software, if it is installed on the user's machine, and can initiate a "URL Message" construction automatically. The VideoShare Producer 20 software can automatically fill out the URL that references the playback of the user's video. The recipient of this URL Message can view the video by clicking a mouse on the URL to be taken directly to the VideoShare web site, where the video can be displayed"*).

**Regarding claim 3**, Hashemi/Liwerant teaches that receiving the request from the instant message sender's client computer for the particular video clip to be delivered to the instant message recipient's client computer comprises receiving a request that is generated in response to a communication from the instant message sender to the instant message recipient (see Hashemi paragraph [0039]; *"In one embodiment, when a user computer communicates with another user computer to send a stream of a media clip"*).

**Regarding claim 5**, Hashemi/Liwerant teaches that receiving the request for the particular video clip including the video clip identifier further comprises receiving a video clip identifier that references a location on the host system of the selected video clip (see Hashemi paragraph [0081]; *"The File Reference field 616 can contain information such as a filename and path for the corresponding media clip on the user computer identified in the Peer Computer Reference field 612"*, a media clip identifier includes the location of the media clip on the host system).

**Regarding claim 6**, Hashemi/Liwerant teaches that the video clip identifier further comprises a file name (see Hashemi paragraph [0081]; *"The File Reference field 616 can contain information such as a filename and path for the corresponding media clip on the user computer identified in the Peer Computer Reference field 612"*, a media clip identifier includes the filename of the media clip).

**Regarding claim 7**, Hashemi/Liwerant teaches that receiving the request for the particular video clip including the video clip identifier comprises receiving a video clip identifier created for the selected video clip based upon the application of an algorithm



to at least a portion of the selected video clip (see Liwerant paragraph [0048]; *"The streaming server D 40 also creates one or more identifiers for the video file. The identifiers, which are discussed in more detail below, can include, for example, one or more of an image identifier (for example, a "thumbnail" or iconic image), an identification tag, a file handle, a storage location, an address such as a Universal Resource Locator (URL), a file name, or an interactive control, or a control object operating according to the Component Object Model (COM), for example an Active X control"*).

**Regarding claim 8**, Hashemi/Liwerant teaches that receiving the request for the particular video clip including the video clip identifier comprises receiving the video clip identifier in response to a communication from the instant message sender to the instant message recipient (see Hashemi paragraph [0039]; *"In one embodiment, when a user computer communicates with another user computer to send a stream of a media clip"*, the identifier inherently must be sent before the media clip can be accessed).

**Regarding claim 9**, Hashemi/Liwerant teaches that the host comprises a server authorized as a partner to an instant messaging host (see Hashemi paragraph [0058]; *"the list of media clips may advantageously be exchanged through the central server 102, which can also be configured to store the list of media clips"*, Hashemi's invention utilizes centralized peer-to-peer file sharing).

**Regarding claim 10**, Hashemi/Liwerant teaches that storing the video clips comprises storing one or more still photographs and a sound track (see Hashemi paragraph [0021]; *"A media clip includes at least a portion of an audio work or a video*

*work, which has been recorded or stored"*, a video clip is inherently the same as one or more still photographs and a sound track).

**Regarding claim 11**, Hashemi/Liwerant teaches that storing the video clips comprises storing an animation sequence (see Hashemi paragraph [0021]; *"A media clip includes at least a portion of an audio work or a video work, which has been recorded or stored"*, a video clip can reasonably be interpreted as being the same as an animation sequence).

**Regarding claim 19**, Hashemi/Liwerant teaches determining whether the particular video clip is an official item; and displaying the particular video clip if the video clip is an official item. The specification of the instant application is silent as to how to differentiate an "official item" from a regular item. Therefore, this dependent claim is not patentably distinct from its parent claim and does not recite any additional limitations.

**Claims 20 and 21** recite significantly the same limitations as claim 1 and are therefore rejected under the same rationale.

**Regarding claim 22**, Hashemi/Liwerant teaches determining capabilities of the instant message recipient's client computer at the host system, and in which accessing the particular video clip comprises determining an appropriate version from one or more versions of the particular video clip based upon the determined capabilities and accessing the appropriate version of the particular video clip (see Liwerant paragraph [0142]; *"FIG. 6C shows a flow diagram 602 of an embodiment of the invention in which software automates a number of steps in the formatting of a video segment. In particular, in this embodiment, the video segment that the user wishes to provide in*

*streaming video format is compressed into a plurality of formats, each of which is encoded for optimal display at a different transmission bitrate. There can be a benefit to recording the same video segment in multiple formats. For example, a casual viewer may have only a slow speed modem, such as a 28.8 kilobaud (kB) modem. For such a viewer, the slow transmission speed can make the size of a file a critical feature. Such a user can view a video in real time if it is formatted for a 28.8 kB modem, but not if it is formatted for appreciably higher transmission speeds. Another user, for example, one who has a T1 connection that can handle transmission speeds up to approximately 1.5 megabaud, could successfully receive a version of the same video segment that is formatted for higher transmission speeds, with the possibility of having a better quality image and higher resolution, perhaps with better audio as well. The T1 user could see the version of the video segment intended for 28.8 kB transmission if he or she wanted to, but might prefer to see a video segment that appeared to be more professional in quality. By using a system that can automatically discriminate the transmission speed capabilities of the hardware that the user employs, the embodiment allows each user to view a version of the video segment that is optimally configured for the user's hardware").*

**Regarding claim 23**, Hashemi/Liwerant teaches that determining capabilities comprises determining a data connection speed of the instant message recipient's client computer (see Liwerant paragraph [0142]).

**Regarding claim 24**, Hashemi/Liwerant teaches that determining capabilities comprises identifying hardware associated with the instant message recipient's client computer (see Liwerant paragraph [0142]).

**Regarding claim 25**, Hashemi/Liwerant teaches that determining capabilities comprises identifying software associated with the instant message recipient's client computer (see Liwerant paragraph [0142]).

**Claim 26** recites a method with substantially the same limitations as the method of claim 1. Therefore, claim 26 is rejected under the same rationale.

**Claims 27, 29, 31, 32-37, and 45-51** recite a computer program with substantially the same limitations the method of claims 1, 3, 5, 6-11, and 19-25, respectively. Therefore, the claims are rejected under the same rationale

**Claim 52** recites a computer program with substantially the same limitations as the method of claim 26. Therefore, claim 52 is rejected under the same rationale.

**Regarding claim 53**, Hashemi/Liwerant teaches that providing the instant message sender with access to the collection of video clips stored on the host system comprises sending a list of the available video clips to the instant message sender's client computer (see Hashemi paragraph [0025]; *"A media clip selection module 136 permits a user to select which media clips from a list of media clips may be received in a stream from another user computer"*).

**Regarding claim 54**, Hashemi/Liwerant teaches receiving, at the host system, a request from the instant message sender's client computer to preview the particular video clip from the collection of video clips stored on the host system; in response to

receiving the request to preview the particular video clip, accessing the particular video clip from the collection of video clips stored on the host system and communicating the particular video clip from the host system to the instant message sender's client computer for previewing, wherein receiving the request from the instant message sender's client computer for the particular video clip to be delivered to the instant message recipient's client computer occurs after the particular video clip has been sent to the instant message sender's client computer for previewing. The invention as taught by Hashemi is capable of allowing the sender to view a video clip prior to sending it to another user via an instant message (chat) application (see Hashemi paragraph [0066]; *"The selected media clips can further include media clips that may advantageously be locally accessible from the user's computer"*; see also paragraph [0047]; *"One embodiment permits the users within a peer group to simultaneously chat while a media clip may advantageously be streamed from one user in the peer group to other users in the peer group"*).

**Claims 55 and 56** recite substantially the same limitations as claims 53 and 54, respectively. Therefore, the claims are rejected under the same rationale.

Claims 12-15 and 38-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hashemi (2003/0212804) *supra*, Liwerant (2002/0056123) *supra*, and Snyder et al. (hereinafter Snyder), United States Patent number 6,070,171.

**Regarding claims 12-15**, Hashemi/Liwerant teaches all the limitations of claims 12-15 except that storing the video clips comprises storing one or more video clips

configured to expire upon the occurrence of a predetermined event; the predetermined event comprises passage of a predetermined length of time or the passage of a predetermined date; the predetermined event comprises a predetermined number of uses; determining whether a video clip has expired, and disallowing access to the video clip if the video clip has expired. However, Snyder teaches disallowing access to software content after a predetermined duration or number of uses (see Snyder column 12 lines 44-49; *"Other examples of Software Payloads (SP) for use with the present invention are on game disks and film on CDROMs whereby copying is prevented and/or time of use is constrained. Also, rental software can use the invention to limit the duration of use and/or the number of uses"*). It would have been obvious to one of ordinary skill in the art at the time the invention was made to likewise disallow access (as taught by Snyder) to other media content such as video (as taught by Hashemi/Liwerant) for the purpose of protecting the intellectual property rights of video.

**Claims 38-41** recite a computer program with substantially the same limitations as the method of claims 12-15. Therefore, the claims are rejected under the same rationale.

Claims 16-18 and 42-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hashemi (2003/0212804) *supra*, Liwerant (2002/0056123) *supra*, and Levi et al. (hereinafter Levi), United States Patent Application Publication number 2003/0236835.

**Regarding claims 16-18,** Hashemi/Liwerant teaches all the limitations of claims 16-18 except determining whether a video clip has been banned, and disallowing access to the video clip if the video clip has been banned; determining whether the video clip has been banned comprises determining whether the video clip has been banned based on a report by a user; and determining whether the video clip has been banned comprises determining whether the video clip has been banned based on a violation of a term of a service agreement. However, Levi teaches instant messaging software in which users can report abuse by other users to ban them (see Levi paragraph [0052]; *"In addition, the profile option allows a user to report abuse to the administrative manager if the sender of the video mail is forwarding threatening or otherwise inappropriate messages. This abuse option allows users to effectively control specific abuse instances which are directed at the user. In this manner, the abusive user need not be globally banned, but can be restricted via the administrative manager (discussed below) with respect to this particular user"*). It would have been obvious to one of ordinary skill in the art at the time the invention was made to impose the same methods for reporting abuse and banning users as taught by Levi on the media clips of Hashemi/Liwerant for the purpose of enforcing a service agreement for the use of the media clips.

**Claims 42-44** recite a computer program with substantially the same limitations as the method of claims 16-18. Therefore, the claims are rejected under the same rationale.

### ***Response to Arguments***

Claims 27, 29, and 31-52 stand rejected under 35 U.S.C. 101 because (1) they recite a tangible computer readable medium that includes a propagated signal, and (2) they recite software *per se*.

(1) The word "tangible" is not explicitly defined in the specification, so it can still be argued that a propagated signal is tangible. Cancelling the "propagated signal" portion of the specification might overcome the rejection.

(2) No execution of the software instructions is recited in the claims. Claim language reciting executing the program on the computer readable medium might overcome the rejection.

Applicant's arguments with respect to claims 1, 3, 5-27, 29, and 31-56 have been considered but are moot in view of the new ground(s) of rejection. Newly introduced prior art Liwerant (2002/0056123) *supra* teaches a method of sharing a video segment over a computer network that comprises storing, on a host system that is separate from both the client computer of the instant message sender and the client computer of the instant message recipient, a collection of video clips that are available to be sent to instant message recipients in instant messaging communications sessions.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP



§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Alvesteffer whose telephone number is (571)270-1295. The examiner can normally be reached on Monday-Friday 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Bashore can be reached on (571)272-4088. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2175

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Stephen Alvesteffer  
Examiner  
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